

REMARKS

Claims 1-19 are pending in this application. Claims 1, 5, 13 and 14 are independent claims. Reconsideration and allowance of the present application are respectfully requested.

Claim Rejections

Rejections Under 35 U.S.C. § 103 – Terasawa et al.

Claims 1-8 and 11-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0147365 (“Terasawa et al.”). This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Applicants respectfully submit that the Examiner cannot establish a *prima facie* case of obviousness with respect to any of claims 1, 5, 13 and 14. Terasawa teaches buffering sequences (signals) after they are received and selected (*Terasawa*: paragraph 55). Thus, Terasawa does not teach or suggest a signal selector that “buffers the first codes and the second codes, then selectively outputs either of the first codes or second codes” as is required by claim 1. Accordingly, Terasawa does not teach or suggest each of the limitations in claim 1. Consequently, the Examiner cannot establish a *prima facie* case of obviousness with respect to claim 1 as is required to support a rejection under §103.

Additionally, claims 5, 13 and 14 contain limitations similar to those of claim 1. Accordingly, the Examiner cannot establish a *prima facie* case of obviousness with respect to any of claims 5, 13 and 14 as is required to support a rejection under §103.

Furthermore, at least in view of their dependency from claims 1, 5 and 14, the Examiner cannot establish a *prima facie* case of obviousness with respect to any of claims 2-4, 6-8 and 10-12.

The Applicants note that with respect to claims 1, 5, 13 and 14, the Examiner asserts that a rearrangement of parts involves only routine skill in the art quoting *In re Japikse*. First, claim 14 is a method claim. With respect to claim 14, there are no parts to rearrange. The Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 14 because claim 14 recites a specific ordering of steps not taught or suggested by Terasawa.

Next, with respect to rearranging parts being obvious the following has been held:

"The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). MPEP §2144.04(VI)(C).

The Examiner did not provide motivation from the prior art for making the proposed rearrangement of parts. Accordingly, the Examiner's assertion that a rearrangement of parts involves only routine skill in the art is insufficient on its own to establish a finding of obviousness.

Therefore, Applicants respectfully request that this rejection of claims 1-8 and 11-19 under 35 U.S.C. §103 be withdrawn.

Allowable Subject Matter

Applicants note with appreciation the Examiner's indication that claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

CONCLUSION

In view of the above remarks and amendments, Applicants respectfully submit that each of the rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John A. Castellano at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By

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